

Nalco Docket No.: 7780-NES
Customer No. 000049459

REMARKS

This is in reply to the Office Action mailed on June 25, 2007 ("Office Action").

Claims 1-28 are currently pending.

Claims 22-28 are withdrawn from consideration pursuant to a restriction requirement under 35 U.S.C. § 121.

Claims 1, 17 and 19-21 are rejected under 35 U.S.C. § 102(b) over U.S. Patent 4,163,646 ("Oude Alink").

Claim 2 is rejected under 35 U.S.C. § 103(a) over U.S. Patent 4,163,646 ("Oude Alink").

Claims 1, 2 and 17-21 are rejected under 35 U.S.C. §§ 102(b)/103(a) over U.S. Patent 6,323,164 ("Liesen").

Claims 3, 4, 6, 8-10 and 15 are rejected under 35 U.S.C. § 103(a) over U.S. Patent 6,323,164 ("Liesen").

Claims 5, 7 and 11-16 are rejected as being based upon a rejected base claim.

Claim 1 is amended to particularly point out and distinctly claim subject matter which Applicant regards as his invention. Support for this amendment is found in original claim 3 and in the specification at page 5, lines 16-18.

Claim 3 is canceled and its subject matter is incorporated into amended claim 1.

Claims 4-8 and 11-16 are amended to maintain proper dependency.

No new matter is added by this amendment.

Nalco Docket No.: 7780-NES
Customer No. 000049459

DISCUSSION

The Rejection of Claims 1 and 17-21 under 35 U.S.C. § 102(b) over U.S. Patent 4,163,646

Claims 1, 17 and 19-21 are rejected under 35 U.S.C. § 102(b) over U.S. Patent 4,163,646 ("Oude Alink").

Applicant respectfully traverses this rejection.

Applicant has amended claim 1 to recited a polymer in which component (c) is selected from styrene, vinyl acetate, maleic anhydride, vinyl cyclohexane, vinyl propionate and cinnamic acid C₁-C₄ alkyl esters.

Applicant respectfully asserts that amended claim 1 expressly excludes any polymers comprising N-vinylpyrrolidone units as disclosed by Oude Alink. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1, 17 and 19-21 under 35 U.S.C. § 102(b) over Oude Alink.

The Rejection of Claim 2 under 35 U.S.C. § 103(a) over U.S. Patent 4,163,646

Claim 2 is rejected under 35 U.S.C. § 103(a) over U.S. Patent 4,163,646 ("Oude Alink").

Applicant respectfully traverses this rejection.

As discussed above, Applicant has amended claim 1 to exclude polymers comprising N-vinylpyrrolidone units. As Oude Alink discloses different polymers, Applicant respectfully asserts that one of skill in the art would have no motivation to look to the teachings of Oude Alink for inspiration with respect to the molecular weight of the claimed polymers. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 2 under 35 U.S.C. § 103(a) over Oude Alink.

The Rejection of Claims 1, 2 and 17-21 under 35 U.S.C. §§ 102(b)/103(a) over U.S. Patent 6,323,164

Claims 1, 2 and 17-21 are rejected under 35 U.S.C. §§ 102(b)/103(a) over U.S. Patent 6,323,164 ("Liesen").

Applicant respectfully traverses this rejection.

Nalco Docket No.: 7780-NES
Customer No. 000049459

Applicant respectfully asserts that Liesen discloses a polymer comprising from about 12 to about 18 weight percent methyl methacrylate; from about 75 to about 85 weight percent of a C₁₀-C₁₅ alkyl methacrylate; and from about 2 to about 5 weight percent of a nitrogen-containing dispersant monomer. See Abstract.

Amended claim 1 paraffin inhibitor comprising a polymer consisting of (a) about 1 to about 98 weight percent of one or more C₁-C₃₀ alkyl esters of acrylic acid; (b) about 1 to about 98 weight percent of one or more C₁-C₃₀ alkyl esters of methacrylic acid; and (c) about 1 to about 30 weight percent of one or more unsaturated monomers selected from the group consisting of styrene, vinyl acetate, maleic anhydride, vinyl cyclohexane, vinyl propionate and cinnamic acid C₁-C₄ alkyl esters and wherein the alkyl ester portion of at least one of (a) or (b) is C₁₀-C₃₀ alkyl.

Applicant respectfully asserts that amended claim 1 does not read on any polymer which contains a nitrogen-containing dispersant monomer. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1, 2 and 17-21 under 35 U.S.C. § 102(b) over Liesen.

Applicant further respectfully asserts that nothing in Liesen teaches or suggests a polymer which must contain both C₁-C₃₀ alkyl esters of acrylic acid and C₁-C₃₀ alkyl esters of methacrylic acid, which does not contain a nitrogen-containing dispersant monomer and which must contain one or more unsaturated monomers selected from the group consisting of styrene, vinyl acetate, maleic anhydride, vinyl cyclohexane, vinyl propionate and cinnamic acid C₁-C₄ alkyl esters. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1, 2 and 17-21 under 35 U.S.C. § 103(a) over Liesen.

The Rejection of Claims 3, 4, 6, 8-10 and 15 under 35 U.S.C. § 103(a) over U.S. Patent 6,323,164

Claims 3, 4, 6, 8-10 and 15 are rejected under 35 U.S.C. § 103(a) over U.S. Patent 6,323,164 ("Liesen").

Applicant respectfully traverses this rejection.

As noted above, amended claim 1 recites a polymer where component (c) is selected from styrene, vinyl acetate, maleic anhydride, vinyl cyclohexane, vinyl propionate and cinnamic acid C₁-C₄ alkyl esters.

Nalco Docket No.: 7780-NES
Customer No. 000049459

Applicant respectfully asserts that while, as noted by the Examiner, Liesen allows for a "minor amount" of additional monomers, which can include styrene or vinyl acetate in the disclosed polymer, Liesen does not disclose a polymer in which the nitrogen-containing dispersant monomer is replaced with this additional monomer. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 3, 4, 6, 8-10 and 15 under 35 U.S.C. § 103(a) over Liesen.

Request for Rejoinder

Applicant respectfully reasserts the request for rejoinder presented in the Amendment and Reply dated October 16, 2006 and respectfully requests rejoinder of claims 22-28 with claims 1-21 for the reasons set forth therein.

Nalco Docket No.: 7780-NES
Customer No. 000049459

RECEIVED
CENTRAL FAX CENTER

SEP 24 2007

CONCLUSION

In view of the foregoing amendment and remarks, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. §§ 102(b) and 103(a) and rejoinder of claims 22-28 with claims 1-27 and respectfully asserts that this application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully Submitted,



Michael B. Martin, Reg. No. 37,521
Nalco Company
Patent & Licensing Department
1601 W. Diehl Road
Naperville, IL 60563-1198

Date: 9/24/07